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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,688	04/16/2001	Paul J. Britten	4361-000002	5734

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HARNES, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT PAPER NUMBER

3628

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,688

Applicant(s)

BRITTEN ET AL.

Examiner

Siegfried E. Chencinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, known as Group I, drawn to a method of sharing revenues generated from sales of banners that are affixed to truck bodies.

Claims 1-4 are in class 705, subclass 26.

II. Claims 5-11, known as Group II, drawn to facilitating banner advertising on truck bodies, the banner advertising comprising affixing banners to the sides of the truck bodies.

Claims 5-11 are in class 705, subclass 14

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination shown above does not require the particulars of the subcombination as claimed. The subcombination has separate utility such as having media buyers identifying truck body owners who are willing to carry banner advertising on their trucks.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Ronald Fuller on August 31, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

2. Claim 2 is objected to because of the following informalities:

- A typographical error in which the word "truck" is misspelled as "track" in the phrase "hardware on the track bodies".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4 are rejected because the claimed invention is directed to non-statutory subject matter. Claims 1-4 lack technological art because they are not directed to any one of the areas of patentable subject matter, such as product, process, process of making or composition.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result,

AND

2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result.

The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. Ex parte Bowman 61USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished).

According to the above guidelines, Applicant's claims are limited to the manipulation of abstract ideas in the context of patentability.

Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 - 4 are rejected under 35 U.S.C. 103(a) as being disclosed by Oliver et al. (US PreGrant Publication 2002/0133412 A1) in view of Waters (US PreGrant Publication 2002/0032659 A1), Applicant admitted prior art and well known prior art.

Re. Claim 1, Oliver discloses a method of sharing revenues generated from online sales of information carried on the online information system of participating information provider entities, comprising the steps of:

- an online information service provider host entity which provides online access to user customers and links to other information providers (Abstract – ll. 21-27; [0021] – ll. 4-8, [0037] – ll. 5-16);
- the participating online information service provider entity receiving a share of revenues from sales to registered users who achieve access to participating information service providers through the host information service provider (Abstract – ll. 21-27; [0021] – ll. 4-8, [0037] – ll. 5-16).

Oliver does not explicitly disclose a method of sharing revenues generated from sales of banners that are affixed to truck bodies, comprising the steps of:

- a manufacturer of the truck bodies manufacturing the truck bodies with mounting hardware for the banners;
- the manufacturer receiving a share of revenues from sales by a banner seller of banners to be affixed to truck bodies made by the manufacturer with the mounting hardware for the banners.

However, Applicant admits that advertising on truck bodies was well known prior to applicant's invention, including the related truck body advertising banner hardware fastening technology and the superwide printing technology on industrial fabrics which can withstand the forces to which they become subjected when attached to a truck body while the truck operates on roads and highways. Applicant also admits to knowing of various schemes for marketing such truck body banner advertising. Further, Applicant admits to revenue sharing incentive schemes to already have existed among some of the parties involved in the enabling of truck body advertising (Specification – p. 1, [0002] – [0007]; Fig. 1). Waters discloses an incentive revenue

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sharing "System and Method for Obtaining and Developing Technology for Market" (Title). The incentive is offered to potential contributors of patentable ideas which are in turn marketed for the generation of license revenue (Abstract). The revenue is shared with the contributors of the sharer(s) ideas which generate the revenue ([0017] – II. 1-9). Consequently, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have realized that the truck body manufacturer could be offered a share of the media buy/advertising revenue being derived from the sale of advertising on truck bodies manufactured by the truck body manufacturer to which he has added advertising banner fastener systems. He would have realized this from the fact that such sharing was already offered to other parties involved in truck body banner advertising, while also obtaining the idea from the ubiquitous nature of revenue sharing incentive schemes being practiced throughout commerce, as exemplified by the disclosures of Oliver and Waters. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the art of Oliver with Applicants' admissions of prior art, with the disclosures of Waters and with well known prior art, for the purpose of offering truck body manufacturers a revenue sharing incentive for providing advertising banner fastening systems, motivated by the opportunity to provide a larger population of truck bodies which have the built-in potential to carry banner advertising in a simple, uncomplicated, inexpensive way by incentivizing the truck body manufacturer to provide a large volume of truck bodies which have the manufacturer's preinstalled advertising banner fasteners on the truck bodies (Oliver, [002], [0005], [0006], [0007], [0008], [0013], [0014]).

Re. Claim 2, neither Oliver nor Waters explicitly disclose a method further including the step of affixing to the banners mounting hardware that mates with the mounting hardware on the truck bodies made by the manufacturer. However, Applicant discloses the well known practice of affixing to the banners mounting hardware that mates with the mounting hardware on the truck bodies made by the manufacturer (Specification, [0003] – II. 3-6). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the art of

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Oliver with Applicants' admissions of prior art, with the disclosures of Waters and with well known prior art for the purpose of including the step of affixing to the banners mounting hardware that mates with the mounting hardware on the truck bodies made by the manufacturer motivated by the opportunity to provide a larger population of truck bodies which have the built-in potential to carry banner advertising in a simple, uncomplicated, inexpensive way by incentivizing the truck body manufacturer to provide a large volume of truck bodies which have the manufacturer's preinstalled advertising banner fasteners on the truck bodies (Oliver, [002], [0005], [0006], [0007], [0008], [0013], [0014]).

Re. Claim 3, Oliver in combination with Applicants' admissions of prior art, the disclosures of Waters and the well known prior art disclose a method of sharing revenues generated from printing banners that are affixed to truck bodies, comprising the steps of a manufacturer of truck bodies manufacturing the truck bodies with mounting hardware for the banners; and a printer printing the banners (see the rejection rationale of claim 1). Neither Oliver nor Applicants' admissions of prior art, Waters and well known prior art explicitly disclose a printer sharing with the manufacturer (of truck bodies) a portion of the revenues the printer receives for printing the (truck body advertising) banners. However, per the rationale presented in the rejection of claim 1, especially Applicant's admission of revenue sharing already having been practiced among some of the parties involved with the facilitation of truck body advertising, it would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the art of Oliver with Applicants' admissions of prior art, with the disclosures of Waters and with well known prior art, for the purpose of a printer sharing with the manufacturer (of truck bodies) a portion of the revenues the printer receives for printing the (truck body advertising) banners, motivated by the opportunity to provide a larger population of truck bodies which have the built-in potential to carry banner advertising in a simple, uncomplicated, inexpensive way by incentivizing the truck body manufacturer to provide a large volume of truck bodies which have the manufacturer's preinstalled advertising banner

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fasteners on the truck bodies (Oliver, [002], [0005], [0006], [0007], [0008], [0013], [0014]).

Re. Claim 4, neither Oliver nor Waters nor well known prior art explicitly disclose the step of affixing to the banners mounting hardware that mates with the mounting hardware on the truck bodies. However, Applicants' admissions of prior art inherently disclose the step of affixing to the banners mounting hardware that mates with the mounting hardware on the truck bodies (Specification, [0004]). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the art of Oliver with Applicants' admissions of prior art, with the disclosures of Waters and with well known prior art, to include the step of affixing to the banners mounting hardware that mates with the mounting hardware on the truck bodies, motivated by the opportunity to provide a larger population of truck bodies which have the built-in potential to carry banner advertising in a simple, uncomplicated, inexpensive way by incentivizing the truck body manufacturer to provide a large volume of truck bodies which have the manufacturer's preinstalled advertising banner fasteners on the truck bodies (Oliver, [002], [0005], [0006], [0007], [0008], [0013], [0014]).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

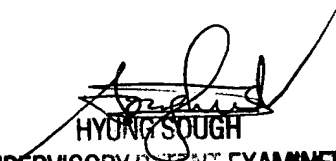
Commissioner of Patents and Trademarks, Washington D.C. 20231
or (571)273-8300 [Official communications; including After Final communications
labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or
"DRAFT"]

Hand delivered responses should be brought to the address found on the above
USPTO web site in Alexandria, VA.

SEC

September 6, 2005


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600